

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

AF/1209H
PATENT
APPLICATION

Re: PATENT APPLICATION of

Inventor(s): Bradshaw et al.

Appln. No.: 09

Series Code ↑

664,794

Serial No. ↑

Group Art Unit: 1734

Examiner.: James Seils

Atty. Dkt. P 271077

M#

Dkt 7-CON

Client Ref

Filed: September 19, 2000

Title: Laminating and Adhesive Transfer Apparatus

Date: February 13, 2003

RECEIVED
FEB 21 2003
TC 1700

Hon. Commissioner of Patents
Washington, D.C. 20231

Sir:

1. ☐ **NOTICE OF APPEAL:** Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision (not Advisory Action) dated _____ of the Examiner twice/finally rejecting claim(s) in this application or in this application and its parent application.
2. ☒ **BRIEF** on appeal in this application attached in triplicate (extendable up to 5 months).
3. ☐ An **ORAL HEARING** is respectfully requested under Rule 194 (due two months after Examiner's Answer- unextendable)
4. ☐ Reply Brief is attached in triplicate (due two months after Examiner's Answer - unextendable).
5. ☐ "Small entity" statement filed: ☐ herewith. ☐ previously.
6. ☐ Fee **NOT** required because paid in prior appeal in which the Board of Patent Appeals and Interferences did not render a decision on the merits (35 USC 134).

7. FEE CALCULATION

	Large/Small Entity		Fee Code
If box 1 above is X'd, enter	\$320/160	\$0	119/219
If box 2 above is X'd, enter	\$320/160	\$320	120/220
If box 3 above is X'd, enter	\$280/140	\$0	121/221
If box 4 above is X'd, enter nothing	- 0 - (no fee)		
8. Original due date: December 19, 2002			
9. Petition is hereby made to extend the original due date (1 mo) \$110/\$55 to cover the date this response is filed for which the (2 mos) \$410/\$205 requisite fee is attached. (3 mos) \$930/\$465 (4 mos) \$1,450/\$725 (Usable only if box 2 is X'd--- 5 mos) \$1,970/\$985			115/215
			116/216
			117/217
			118/218
			128/228
10. Enter any previous extension fee paid <input checked="" type="checkbox"/> previously since above Original due date (item 8); <input type="checkbox"/> with concurrently filed amendment	-\$110		
11. Subtract line 10 from line 9 and enter: Total Extension Fee		+\$300	
12. TOTAL FEE =		\$620	

(Our Deposit Account No. 03-3975)

(Our Order No. 81069

C#

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PLEASE CHARGE
OUR DEP. ACCT.

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached.
This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of
BRADSHAW et al.

Application No: 09/664,794

Filed: Sept 19, 2000

FOR: LAMINATING AND ADHESIVE TRANSFER APPARATUS

Confirmation No: 1859

Group Art Unit: 1734

Examiner: James D. Sells

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February 14, 2003

APPEAL BRIEF

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

Applicant hereby submits in triplicate this Appeal Brief appealing the rejection of claims 36-48 of the present application, the Notice of Appeal having been filed on January 17, 2003.

I. Real Parties In Interest

The real party in interest is the assignee Xyron, Inc.

II. Related Appeals and Interferences

There are no related appeals or interferences.

III. Status of the Claims

Claims 36-48 are currently pending in the present application, and all stand under final rejection. The final rejection of claims 36-48 is the subject of this appeal.

IV. Status of Amendments

The attached Appendix sets forth the claims currently pending in the present application. There are no unentered amendments.

V. Summary of the Invention

The present invention relates to an apparatus and method for processing a master in conjunction with a supply of a first feed material and a supply of a second feed material, at least one of the feed materials carrying a layer of adhesive. The apparatus is defined in claim 36. In the Figures, the apparatus is generally indicated at 10 and the supplies of first and second materials correspond to the materials on rolls 100,110.

The apparatus 10 comprises a frame having an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting the apparatus 10 and (b) an upper outer shell portion movably connected to the lower shell portion. The upper shell portion is movable between an open position and a closed position relative to the lower outer shell portion by manually engaging the upper outer shell portion directly and lifting the upper outer shell portion upwardly to the open position thereof. The frame corresponds generally to the overall structure mounting the various components of the apparatus. The lower outer shell portion is indicated at 12 in the Figures, the upper outer shell portion is indicated at 14, and collectively these comprise the claimed outer shell. These shell portions 12 and 14 are clearly movable as recited. The open position is illustrated in Figure 3 and the closed position is illustrated in Figures 1, 2, and 5.

The apparatus also comprises a pair of cooperating pressure applying structures located within the outer shell. The cooperating structures correspond to the nip rollers 60, 80. The cooperating structures 60, 80 are constructed and arranged to be positioned adjacent one another in a cooperating pressure applying relationship. In this relationship, when the master, with the first and second feed materials on opposing sides thereof and the adhesive contacting the master, is positioned between the cooperating structures, the cooperating structures 60, 80 apply pressure to the master and feed materials as they advance therethrough so as to bond the adhesive to the master. An upper one of the pair of the cooperating pressure applying structures, namely upper nip roller 60, is connected with the upper outer shell portion 12 as shown in the Figures. This enables movement of the upper outer shell portion 12 to the open position thereof (Figure 3) to move the upper one of the cooperating pressure applying structures 60 apart from a lower one of the cooperating pressure applying structures 80 to facilitate positioning of the feed materials in between the cooperating structures 60, 80. This also enables movement of the upper outer shell portion 12 to the closed position (Figure 2) thereof to position the upper one of the cooperating

structures 60 adjacent the lower one of the cooperating pressure applying structures 80 in the cooperating pressure applying relationship. As can be seen plainly in the Figures, and particularly Figures 2 and 3, the upper nip roller 60 is connected with the upper shell portion 14 and moves with the upper shell portion 12 as recited in claim 36.

The frame also provides a first mounting portion constructed to receive and mount the supply of the first feed material and a second mounting portion constructed and arranged to receive and mount the supply of the second feed material. The first and second mounting portions correspond to the slots indicated in the Figures at 28, 28A, 56, 56A and shown as being on the frame walls.

The method of the invention is defined in claim 47 and comprises the following acts. The upper outer shell portion 12 is manually engaged directly and lifted upwardly to the open position thereof, as shown in Figure 3. Then, the first and second feed materials are disposed in such a position with respect to the cooperating pressure applying structures 60, 80 that, when the upper outer shell portion 12 is lowered to the closed position (Figure 2) thereof to move the upper one of the cooperating structures 60 adjacent the lower one 80 in the cooperating pressure applying relationship thereof, the first and second feed materials will be positioned between the cooperating structures 60, 80. That is, with the upper shell portion 12 in its open position, the upper cooperating structure 60 moved apart from the lower one 80 so that the feed materials can be “loaded” by placing them over the lower cooperating structure 80 whereby they will be engaged by the upper cooperating structure 60 upon lowering of the upper shell portion. 12. This is discussed at column 3, lines 53-63.

Then, the upper outer shell portion 12 is lowered to the closed position thereof (Figure 2) to position the upper one of the cooperating structures 60 adjacent the lower one of the cooperating pressure applying structures 80 in the cooperating pressure applying relationship thereof with the first and second feed materials positioned therebetween. This is reflected at column 3, lines 64-66 wherein the specification states “[t]he upper frame member is then rotated to a closed position bringing the nip rollers 60 and 80 into engagement or close proximity with the webs 102, 112 and master 125 compressed therebetween.” Next, while the upper outer shell portion 12 is in the closed position thereof, the master, with the first and second feed materials on opposing sides thereof and the adhesive contacting the master, is advanced between the cooperating structures 60, 80. This causes the cooperating structures 60, 80 to apply pressure to the master and feed materials. This bonds the adhesive to the master. See column 4, lines 24-38 for a description of this action.

VI. Issue

Whether claims 36-48 are patentable under 35 U.S.C. § 251, and specifically whether those claims contain materially narrowing limitations sufficient to avoid application of the recapture rule.

VII. Grouping of Claims

Independent claim 36 and its dependent claims 37-46 stand or fall together, and independent claim 47 and its dependent claim 48 stand or fall together. However, claims 36-46 are separately patentable from claims 47 and 48.

VIII. Argument

A. Summary of the Argument

The Applicants submit that the recapture rule does not bar the patentability of independent claims 36 and 47, and thus these claims and their respective dependent claims are patentable under 35 U.S.C. § 251. Specifically, neither of these independent claims impermissibly recaptures the claim scope sought during the original prosecution of the '962 patent, as each independent claim contains limitations narrowing them in material respects relative to both the claims originally sought during the prosecution of the '962 patent, and the claims ultimately issued in the '962 patent.

B. Detailed Discussion of the Argument for Claim 36

1. The Recapture Rule Does Not Apply When The Reissue Claim Is Narrower Than The Claim Originally Sought

Under the recapture rule, canceling a claim in lieu of a narrower claim, or narrowing a claim by amendment, operates as an admission that the cancelled claim or the claim in its form prior to amendment is unpatentable, and prohibits the patentee from attempting to obtain a claim of the same or broader scope through a reissue application. See Ball Corp. v. U.S., 729 F.2d 1429, 1436 (Fed. Cir. 1984). This is because the patentee's decision to surrender that claim scope by amending or canceling the claim is a deliberate decision that cannot be considered an error within the meaning of 35 U.S.C. § 251. See Haliczer v. U.S., 356 F.2d 541,545 (Ct. Cl. 1966) (holding reissue claims invalid because they were almost exactly the same in scope as claims cancelled during original prosecution).

See also In re Clement, 131 F.3d 1464, 1468-69 (Fed. Cir. 1997). Generally, when an issued patent claim was added to the original application in lieu of a cancelled claim, the appropriate analysis under the recapture rule is to compare the reissue claim to the cancelled claim to determine whether the Applicant on reissue is attempting to recapture the scope of the cancelled claim. This is because “[t]he recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were canceled from the original application.” Ball Corp., 729 F.2d at 1436 (italics in original). When an issued patent claim was the subject of an amendment during the original prosecution, the appropriate analysis under the recapture rule is to compare the reissue claim to the patent claim prior to its amendment. See In re Clement, 131 F.3d at 1469 (“Amending a claim ‘by the inclusion of an additional limitation [has] exactly the same effect as if the claim as originally presented had been cancelled and replaced by a new claim including that limitation.’” (quoting In re Byers, 230 F.2d 451, 455 (CCPA 1956))).

However, a long line of Federal Circuit and CCPA¹ cases have consistently held that a reissue claim narrower in scope than a claim cancelled during prosecution, or a claim prior to amendment during prosecution, avoids application of the recapture rule. See, e.g., Whittaker Corp. v. UNR Industries, Inc., 911 F.2d 709 (Fed. Cir. 1990); Ball Corp. v. U.S., 729 F.2d 1429 (Fed. Cir. 1984); Application of Wadlinger, 496 F.2d 1200 (CCPA 1974); Application of Richman, 409 F.2d 269 (CCPA 1969); Application of Petrow, 402 F.2d 485 (CCPA 1968); and Application of Willingham, 282 F.2d 353 (CCPA 1960). In fact, Ball Corp. expressly acknowledges that “there is widespread agreement that reissue claims that are narrower than the cancelled claims are allowable.” Ball Corp., 729 F.2d at 1438. “The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.” Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 1483 (Fed. Cir. 1998). Further, the recapture rule does not apply because the reissue applicant is not attempting to recapture the claim scope that is the same or broader than sought during prosecution – instead the reissue applicant is pursuing a claim of a different and narrower scope. Specifically, because the reissue applicant is pursuing a claim of different and narrower scope than sought during the original prosecution, it cannot be inferred that the cancellation or amendment of an original claim operates as an admission that the reissue claim is unpatentable. See Application of Willingham, 282 F.2d at 357 (“The appealed [reissue] claims differ materially from cancelled

¹ Prior decisions of the CCPA, a predecessor court of the Federal Circuit, have been expressly adopted by the Federal Circuit as being binding precedent. See South Corp. v. U.S., 690 F.2d 1368 (Fed. Cir. 1982).

claim 12 and there is nothing of record on which to base a holding that the cancellation of claim 12 was in any sense an admission that the reissue claims on appeal were not in fact patentable to appellant at the time claim 12 was deleted.”). See also Ball Corp., 729 F.2d at 1436 (“On the other hand, the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the cancelled claims.” (italics in original)). This is the case with reissue claim 36 because, as will be discussed below, reissue claim 36 is materially narrower than patent claim 10 was prior to being amended during the original prosecution, and thus on reissue the Applicants cannot be considered as recapturing the same scope as claim 10² afforded as issued or prior to being amended.

With respect to patent claim 10, it was amended twice during prosecution to include the following limitations:

pre-tensioning means integrally associated with each of said cores for selectively establishing a predetermined resistance to rotation of the rolls of feed material to provide the proper application tension for the feed material, said pre-tensioning means including a tensioning cap affixed to said associated core having an end plate engaging the associated core and said plate having with securement means engageable in said mounting means and further including biasing means for applying a predetermined force biasing said end plate into engagement with the associated core[.]

✓ The Applicants acknowledge that these limitations are not present in reissue claim 36 and were added to claim 10 of the ‘962 patent for purposes of securing its allowance. Thus, the dispositive issue is whether reissue claim 36, by omitting these limitations, impermissibly recaptures the claim scope that the Applicants surrendered by the amendments made to patent claim 10 during the original prosecution. The Applicants submit ✓ that the recapture rule does not apply because reissue claim 36 contains a number of limitations that render it materially narrower than claim 10 both as originally filed in the application, and as ultimately issued.

Specifically, claim 36 is materially narrower than claim 10 as originally filed and as issued, by virtue of reciting that the “frame” has “an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting said apparatus and (b) an upper outer shell portion movably connected to said lower shell portion for movement between an open

² Claim 10 from the ‘962 patent is the most relevant claim to the recapture analysis as it was directed to the embodiment of Figure 1-10, as is the case with reissue claim 36.

position and a closed position relative to said lower shell portion by manually engaging said upper shell portion directly and lifting said upper shell portion upwardly to said open position thereof[.]” Reissue claim 36 further recites “an upper one of said pair of said cooperating pressure applying structures being connected with said upper outer shell portion such that (a) movement of said upper outer shell portion to said open position thereof moves the upper one of said cooperating pressure applying structures apart from a lower one of said cooperating pressure applying structures to facilitate positioning of said feed materials in between said cooperating structures and (b) movement of said upper outer shell portion to said closed position thereof positions the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship as aforesaid[.]”

These limitations were included to materially narrow claim 36 to the type of device wherein parts of the outer shell, including an upper portion and a lower portion with surfaces that support the apparatus, are movable between open and closed positions to move the cooperating pressure applying structures towards one another by such movement. Claim 10 never included limitations narrowing it to this specific construction. Instead, the corresponding limitations in claim 10 (i.e., an upper frame member pivotally connected to a lower frame member and mounting means associated with each) were so broad as to encompass any construction wherein two parts of a frame with cooperating structures thereon are movable relative to one another. In fact, the Examiner construed these limitations in claim 10 so broadly as to encompass a construction wherein internal parts of the frame were movable relative one another, even though such parts were inaccessible for the user to manually engage and move. An example of such a construction is shown in the prior art U.S. Patent No. 4,619,728 to Brink upon which the Examiner made previous rejections. Reissue claim 36 is now sufficiently and materially narrower so as to exclude that type of construction. Further, the Examiner has not disputed that these limitations do not materially narrow the overall scope of reissue claim 36 relative to claim 10 as issued and/or prior to amendment. Instead, the Examiner has only asserted that they do not materially narrow the omitted “pre-tensioning means.” The Applicants submit that the Examiner’s analysis in this regard is contrary to controlling precedent and respectfully requests the Board to reverse the rejection because the inclusion of these materially narrowing limitations in reissue claim 36 avoids application of the recapture rule.

The CCPA case Application of Richman is directly on point with respect to the issue presented in this appeal and supports the Applicants’ position. In that case, the

patentee applied for reissue claims that omitted a limitation present in the issued patent claims, but not present in the original cancelled claims which is the case here with the “pre-tensioning means.” Specifically the original cancelled claims in Richman broadly recited that a control signal was a unidirectional control signal, but the issued patent claims more narrowly specified the polarity of the control signal’s magnitude. The reissue claims, however, were broader in one aspect because they omitted this polarity limitation. The Examiner rejected the reissue claims because this polarity limitation was removed, broadly stating that “[a]n error of judgment in limiting the claims is not correctable by reissue.” Application of Richman, 409 F.2d at 274. The Board of Appeals affirmed the Examiner’s rejection on this basis, and the reissue applicant subsequently appealed the rejection to the CCPA. On appeal to the CCPA, the Solicitor phrased the issue as follows:

May appellant, having deliberately included a certain limitation in each of his patent claims and successfully urged the patentability thereof over prior art applied against replaced original claims 1-15 on the basis of a maximum-zero control signal relationship represented by the limitation, now omit that limitation in reissue claims 23-28? Id.

The CCPA stated that it did not consider this to be an “accurate statement,” and stated instead that “[t]he question raised is whether the appealed claims are of the same scope as the cancelled claims, not whether they lack some specific recitation absent from the cancelled claims but included in the patent claims.” Id. The CCPA further stated that it found no authority for “the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required. Certainly, one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.” Id. at 274-75.

Applying this analysis, the CCPA reversed the Board on the grounds that “each of the appealed claims is more restrictive in at least one significant respect than the cancelled claims and that the appellant is not seeking, through the presentation of claims 23-28, to recapture the same subject matter that he sought in cancelled claims 1-15.” Id. at 276. Specifically, the CCPA identified other limitations in the reissue claims that made them narrower than the cancelled claims, even though the reissue claims omitted the critical control signal polarity limitation added to the issued patent claims during the original prosecution.

This is exactly the case in this appeal, because even though the “pre-tensioning means” limitations were added to patent claim 10 during the original prosecution, reissue claim 36 is materially narrower by the inclusion of the limitations relating to the outer shell and how its upper and lower outer shell portions move between open and closed positions to facilitate positioning of the feed materials between the cooperating structures.

Whittaker Corp. is another case directly on point. In that case, the patentee “sought to broaden the scope of the ‘882 [patent] claims by removing one of the limitations that had been added during prosecution of the ‘882 patent.” Whittaker Corp., 911 F.2d at 710. The Federal Circuit held that the recapture rule did not apply because limitations in the reissue concerning the location of a hinge resulted in the reissue claims being narrower than the cancelled claims. Specifically, the court stated “[s]ince we hold that the claims of the reissue patent are narrower in scope than the cancelled original claims of the application that resulted in the ‘882 patent, the ‘453 cannot be held invalid under the recapture rule as described in Ball Corp. . . .” Id. at 713.

The facts of this appeal fall squarely within the facts of these cases, which are binding precedent. Specifically, in both Richman and Whittaker, reissue claims omitting a limitation added to the patent claims were found to avoid the recapture rule because of the inclusion of other materially narrowing limitations. This is the case with claim 36 because even though the “pre-tensioning means” limitations added to patent claim 10 are not present in reissue claim 36, reissue claim 36 contains other materially narrowing limitations, such as the limitations discussed above concerning the “frame” and its “outer shell.” Further, this is consistent with the long line of precedential Federal Circuit and CCPA cases cited above that have consistently stated that a reissue claim narrower in scope than a claim cancelled during prosecution, or a claim prior to amendment during prosecution, avoids application of the recapture rule. Moreover, because claim 36 is different and narrower than claim 10 ever was during the original prosecution or as issued, the Examiner could not properly infer that the amendments made to claim 10 operates as an admission that reissue claim 36 is unpatentable. For at least these reasons, the Board is respectfully requested to reverse the Examiner’s rejection of claim 36 based on the recapture rule.

2. Pannu, Anderson, and Mentor Do Not Support the Examiner’s Position

In the most recent Office Action, the Examiner cites Anderson v. Int’l Eng’g & Mfg., Inc., 160 F.3d 1345 (Fed. Cir. 1998), Mentor Corp. v. Coloplast, Inc., 998 F.2d 992

(Fed. Cir. 1993), and Pannu v. Storz Instruments, Inc., 258 F.3d 1366 (Fed. Cir. 2001) as supporting his recapture rejection. In a telephone interview with the Examiner, the Examiner made clear that he was relying primarily on Pannu, which in turn cited Anderson and Mentor. This was confirmed in an Interview Summary dated November 6, 2002. In that Interview Summary, the Examiner clarified his interpretation of Pannu as holding that the narrowing limitations “must be within the surrendered subject matter” (i.e., the “pre-tensioning means”).

With respect to the Examiner’s assertion that the narrowing of reissue claim 36 must be within the “pre-tensioning means” to avoid the recapture rule, this assertion is inconsistent with controlling Federal Circuit and CCPA precedent and thus unsupportable. In making this assertion, the Examiner relies on Pannu. In Pannu, the original patent included a claim limiting a haptics to a particular shape. This claim was added to the original application in lieu of a claim that did not contain that limitation, and which was subsequently cancelled prior to allowance, thus rendering the haptics shape critical to the issued claim. On reissue, the patentee obtained a reissue claim omitting the limitation on the shape of the haptics, but including limitations narrowing a snag-resistant means. The limitations narrowing the snag-resistant means were not present in the cancelled claims. The patentee argued that these narrowing limitations on the snag-resistant means made the claim materially narrower than the cancelled claim originally sought and thus avoided application of the recapture rule. The Federal Circuit disagreed, and found the reissue claim invalid, stating:

The “continuous, substantially circular arc” limitation related to the shape of the haptics. The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. Furthermore, “if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture.” . . . In prosecuting the [original] patent, Pannu specifically limited the shape of the haptics to a “continuous, substantially circular arc.” On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections. Pannu, 258 F.3d at 1372 (internal citations omitted).

✓ At first glance, this language from Pannu arguably seems to support the Examiner’s position. However, reading Pannu in the context of prior Federal Circuit and

CCPA decisions reveals that Pannu cannot be interpreted as precedent supporting the Examiner's position because such an interpretation would be in direct conflict with prior Federal Circuit and CCPA decisions. Specifically, Pannu, which was decided by a three judge panel, and not *in banc*, cannot be interpreted as precedent supporting the Examiner's rejection because such an interpretation would be in direct conflict with Application of Richman, discussed above, a prior CCPA case which has not been overturned. Under Federal Circuit law, prior decisions of the court are binding precedent on subsequent panels (and, of course, on the U.S.P.T.O.) unless and until overturned *in banc*. Where there is a direct conflict, the first decision controls. See Newell Cos. v. Kenney Mfg. Co., 864 F.2d 757, 765 (Fed. Cir. 1988). Further, the Federal Circuit has expressly adopted the decisions of the CCPA, which was the predecessor of the Federal Circuit, as being binding precedent. See South Corp. v. U.S., 690 F.2d 1368, 1370 (Fed. Cir. 1982). Thus, where a prior CCPA decision and a later Federal Circuit decision are in direct conflict and the prior CCPA decision has not been overturned by an *in banc* panel, as is the case here between Pannu and Richman, the CCPA case, namely Richman, controls.

As discussed above, Richman expressly stated that the appropriate analysis under the recapture rule is “whether the appealed claims are of the same scope as the cancelled claims, not whether they lack some specific recitation from the cancelled claims but included in the patent claims.” Application of Richman, 409 F.2d at 274 (underlining added). Further, the CCPA found no authority for the proposition that “a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required.” Id. at 274-75. The CCPA further acknowledged that this could occur where a less specific limitation could have been added or, as is the case with claim 36, a limitation could have been added to another element. See id. at 275.

Pannu, however, runs directly counter to Richman by stating that there is no flexibility in the recapture analysis, and holding that the recapture rule applied even though other narrowing limitations were added to the reissue claims. Under the CCPA's analysis in Richman, the court in Pannu should have considered whether the added limitations on the snag-resistant means materially narrowed the reissue claim relative to the cancelled claim, irrespective of whether the limitations concerning the shape of the haptics were removed. Instead, the Federal Circuit appears to have found the reissue claim invalid only because the limitations on the snag-resistant means did not narrow the haptics, which is not the proper

analysis under Richman. The only authorities the Federal Circuit cited in Pannu in support of its analysis in this respect were Anderson and Mentor, discussed below. It is worth noting that the three judge panel deciding Pannu did not cite Richman, and presumably did not have the opportunity to consider its precedential effect on that case.

Anderson is inapplicable and supports neither the Examiner's rejection or the Federal Circuit's analysis in Pannu because the issue in the Anderson case was whether the patent claims had been broadened during reexamination. This has no bearing on the recapture rule in reissue proceedings. Specifically, broadening of the claims is not permitted during reexamination irrespective of whether additional narrowing limitations are added to the claim. See 35 U.S.C. § 305. Apparently, the court in Anderson was looking to recapture cases for guidance in ascertaining whether an impermissible broadening had occurred during reexamination, which would render the claims invalid. See Anderson, 160 F.3d at 1349. However, Anderson involved no analysis or application of the recapture rule, and certainly no analysis of the applicability of the recapture rule where the reissue claim sought contains materially narrowing limitations. Accordingly, Anderson has no applicability to the present issue on appeal and the Examiner's reliance on it should be disregarded. Further, Anderson was decided by a three judge panel and cannot be considered in any way as overturning the law set forth in Richman or supporting the Examiner's interpretation of Pannu in that regard.

The Mentor case is another three judge panel decision by the Federal Circuit and does address the recapture issue. However, a close reading of Mentor reveals that its analysis of the facts as to the issue of materially narrowed reissue claims is consistent with the Applicants' position on this appeal and is in line with Richman. In Mentor, the Federal Circuit held the reissue claims in that case invalid under the recapture rule. The reissue patentee argued that the reissue claims contained limitations that made the reissue claims materially narrower than claims cancelled during the original prosecution, and thus the reissue claims should be held valid even though they omitted narrowing limitations added to the patent claims during the original prosecution. In reaching its decision, the Federal Circuit did not purport to broadly overturn or depart from its past precedent – instead, as in Richman, it analyzed each new limitation in the reissue claims to determine whether they made the reissue claims materially narrower than the cancelled claims.

For example, in Mentor the court determined that the addition of the term “flexible” to describe a catheter material in the reissue claims was not materially narrowing because the claims already recited that the material was “resilient.” See Mentor, 998 F.2d at

996. This is a correct analysis because a material that is “resilient” is inherently “flexible,” and adding “flexible” to the reissue claim did not materially narrow it. Likewise, the court concluded that inclusion of limitations in the reissue claims that the catheter was rolled outward to form a single roll was not materially narrowing because that was the only way it could be done. Essentially the court in Mentor determined that the recapture rule barred the reissue claims because the newly added limitations had no materially narrowing effect. This is not the case with reissue claim 36 on appeal, because claim 36 includes limitations with respect to the “frame” and its “outer shell” that indisputably make claim 36 materially narrower than patent claim 10, both as issued and as originally filed. Thus, contrary to the Examiner’s reliance on Mentor as supporting his rejection, a close analysis of the facts in Mentor shows that the analysis conducted by the Federal Circuit is the same analysis the Applicants assert the Examiner should have conducted on reissue claim 36. Specifically, the court’s factual analysis in Mentor follows the proper approach by analyzing the added limitations and determining whether they make the reissue claim as a whole materially narrower than the claims sought during the original prosecution, not whether they narrow some limitation that is being broadened in the reissue claim. Further, the analysis conducted by the Federal Circuit in Mentor in this respect is consistent with, not contrary to, the analysis conducted in Richman. Accordingly, the Examiner’s reliance on Mentor as supporting his rejection should be disregarded, and also it cannot be considered as effecting the precedential effect of Richman.

Thus, as Richman is the prior decision and continues to stand as controlling precedent over Pannu, the Board cannot adopt the Examiner’s interpretation of Pannu, because the Examiner’s interpretation would directly conflict with Richman. For at least these reasons, it is respectfully submitted that Pannu cannot support the Examiner’s rejection.

Additionally, the Examiner’s interpretation of Pannu as applying the recapture rule in a rigid, unflexible manner is inconsistent with the liberal approach adopted by the Federal Circuit in Ball Corp., another panel decision made prior to Pannu. Ball Corp. also has not been overturned, and thus is controlling precedent between the two. In Ball Corp., the Federal Circuit expressly adopted the CCPA’s liberal approach to the recapture rule and rejected the rigid approach proposed by the alleged infringer and exemplified by the 9th Circuit case Riley v. Broadway-Hale Stores, Inc., 217 F.2d 530 (9th Cir. 1954). Riley stood for the proposition that a limitation added to the original patent claims during prosecution cannot be broadened during reissue. In adopting the CCPA’s liberal approach, the Federal

Circuit approvingly cited Application of Richman as supporting that the proper focus under recapture “is not . . . on the specific claim limitations or on the elements of the claims, but, rather on the scope of the claims.” Ball Corp., 729 F.2d at 1436 (italics in original). Moreover, the Federal Circuit emphasized that “[t]he proper focus is on the scope of the claims, not on the individual *feature* or *element* purportedly given up during prosecution of the original application.” Id. at 1437 (italics in original).

The Examiner’s application of Pannu in the present case is clearly contrary to the liberal approach adopted by Ball Corp. in that the Examiner focuses only on the “pre-tensioning means” added to claim 10 during prosecution, instead of focusing on reissue claim 36 as a whole, including its other, materially narrowing limitations concerning the “frame” and its “outer shell.” To allow the Examiner to apply Pannu to reissue claim 36 as he has in this case would essentially be following the rigid 9th Circuit approach expressly rejected by the Federal Circuit. This is an additional reason establishing that Pannu cannot support the Examiner’s rejection.

For these additional reasons, the Board is respectfully requested to reverse the Examiner’s rejection against claim 36 under the recapture rule, particularly because it is grounded on inapplicable caselaw.

C. Detailed Discussion of the Argument for Claim 47

Much of the argument provided above with respect to claim 36 applies equally to claim 47, and thus for at least those reasons, reversal of the Examiner’s rejection to claim 47 is requested. However, claim 47 warrants some separate treatment, as it is a method claim and thus is of a different scope from claim 36 and stands separately from claim 36.

For example, while claim 47 recites the same limitations concerning the “frame” and its “outer shell” as apparatus claim 36, claim 47 recites a specific set of acts for using the apparatus. Thus, claim 47 is even more narrow in material respects than claim 36, and this further emphasizes the inappropriateness of the Examiner’s rejection. Further, no method claim was ever presented during the prosecution of the ‘962 patent. Therefore, the Applicants on reissue cannot be recapturing surrendered claim scope by inclusion of method claim 47 because no method claim was ever presented during the prosecution of the ‘962 patent. Thus, the Applicants submit that these additional reasons further support reversal of the Examiner’s rejection against claim 47.

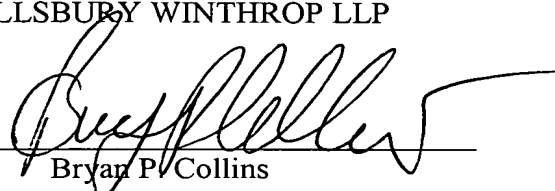
IX. Conclusion

In conclusion, the Applicants respectfully submit that, based on the reasons advanced above, the claims 36-48 are not barred by the recapture rule, and thus are patentable under 35 U.S.C. § 251. Accordingly, reversal of the Examiner's rejection under 35 U.S.C. § 251 with respect to claims 36-48 is requested.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By

A handwritten signature in black ink, appearing to read "Bryan P. Collins", is written over a horizontal line.

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APPENDIX

36. An apparatus for processing a master in conjunction with a supply of a first feed material and a supply of a second feed material, at least one of said feed materials carrying a layer of adhesive, said apparatus comprising:

a frame having an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting said apparatus and (b) an upper outer shell portion movably connected to said lower shell portion for movement between an open position and a closed position relative to said lower outer shell portion by manually engaging said upper outer shell portion directly and lifting said upper outer shell portion upwardly to said open position thereof; and

a pair of cooperating pressure applying structures located within said outer shell, said cooperating structures being constructed and arranged to be positioned adjacent one another in a cooperating pressure applying relationship wherein, when the master with the first and second feed materials on opposing sides thereof and the adhesive contacting the master is positioned between said cooperating structures, said cooperating structures apply pressure to said master and feed materials as they advance therethrough so as to bond said adhesive to said master;

an upper one of said pair of said cooperating pressure applying structures being connected with said upper outer shell portion such that (a) movement of said upper outer shell portion to said open position thereof moves the upper one of said cooperating pressure applying structures apart from a lower one of said cooperating pressure applying structures to facilitate positioning of said feed materials in between said cooperating structures and (b) movement of said upper outer shell portion to said closed position thereof positions the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship as aforesaid;

said frame providing a first mounting portion constructed to receive and mount said supply of said first feed material and a second mounting portion constructed and arranged to receive and mount said supply of said second feed material.

37. An apparatus according to claim 36, wherein said upper and lower outer shell portions are pivotally connected to one another for said relative movement with respect to one another.

38. An apparatus according to claim 37, wherein said outer shell has a pair of opposing side walls each having upper and lower side wall portions pivotally connected to one another, said upper outer shell portion being provided by the upper side wall portions of said side walls and said lower outer shell portion being provided by the lower side wall portions of said side walls.

39. An apparatus according to claim 38, wherein said side walls are parallel to one another.

40. An apparatus according to claim 38, wherein said frame further comprises a feed tray mounted between said lower side wall portions for supporting and guiding the master in between said cooperating structures.

41. An apparatus according to claim 36, wherein at least one of said cooperating pressure applying structures is a rotatable nip roller.

42. An apparatus according to claim 41, wherein both of said cooperating pressure applying structures are rotatable nip rollers.

43. An apparatus according to claim 42, wherein said upper and lower outer shell portions are pivotally connected to one another for said relative movement with respect to one another.

44. An apparatus according to claim 43, wherein said outer shell has a pair of opposing side walls each having upper and lower side wall portions pivotally connected to one another, said upper outer shell portion being provided by the upper side wall portions of said side walls and said lower outer shell portion being provided by the lower side wall portions of said side walls.

45. An apparatus according to claim 44, wherein said side walls are parallel to one another.

46. An apparatus according to claim 44, wherein said frame further comprises a feed tray mounted between said lower side wall portions for supporting and guiding the master in between said cooperating structures.

47. A method for using an apparatus for processing a master in conjunction with a supply of a first feed material and a supply of a second feed material, at least one of said feed materials carrying a layer of adhesive, said apparatus comprising: a frame having an outer shell including (a) a lower outer shell portion having downwardly facing surfaces constructed and arranged to be placed on a substantially flat support surface for supporting said apparatus and (b) an upper outer shell portion movably connected to said lower shell portion for movement between an open position and a closed position relative to said lower outer shell; and a pair of cooperating pressure applying structures located within said outer shell, said cooperating structures being constructed and arranged to be positioned adjacent one another in a cooperating pressure applying relationship wherein, when the master with the first and second feed materials on opposing sides thereof and the adhesive contacting the master is positioned between said cooperating structures, said cooperating structures apply pressure to said master and feed materials as they advance therethrough so as to bond said adhesive to said master; an upper one of said pair of said cooperating pressure applying structures being connected with said upper outer shell portion such that (a) movement of said upper outer shell portion to said open position thereof moves the upper one of said cooperating pressure applying structures apart from a lower one of said cooperating pressure applying structures to facilitate positioning of said feed materials in between said cooperating structures and (b) movement of said upper outer shell portion to said closed position thereof positions the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship as aforesaid, said method comprising:

manually engaging said upper outer shell portion directly and lifting said upper outer shell portion upwardly to said open position thereof;

disposing said first and second feed materials in such a position with respect to said cooperating pressure applying structures that, when said upper outer shell portion is lowered to said closed position thereof to move said upper one of cooperating structures

adjacent the lower one of said cooperating pressure applying structures said cooperating pressure applying relationship thereof, said first and second feed materials will be positioned between said cooperating structures;

then lowering said upper outer shell portion to said closed position thereof to position the upper one of said cooperating structures adjacent the lower one of said cooperating pressure applying structures in said cooperating pressure applying relationship thereof with said first and second feed materials positioned therebetween; and

while said upper outer shell portion is in said closed position thereof and said cooperating structures are in said cooperating pressure applying relationship thereof with said first and second feed materials therebetween, advancing said master with the first and second feed materials on opposing sides thereof and said adhesive contacting the master between said cooperating structures such that said cooperating structures in said cooperating pressure applying relationship thereof apply pressure to said master and feed materials as they advance therethrough so as to bond said adhesive to said master.

48. A method according to claim 47, further comprising, prior to said advancing of said selected substrate, inserting said master between said first and second feed materials and said cooperating structures while said first and second outer shell portions are in said closed position thereof and said cooperating structures are in said cooperating pressure applying relationship thereof.

FULL TEXT OF CASES (USPQ2D)

All Other Cases

Pannu v. Storz Instruments Inc., 59 USPQ2d 1597 (CA FC 2001)

Pannu v. Storz Instruments Inc., 59 USPQ2d 1597 (CA FC 2001)

59 USPQ2D 1597

Pannu v. Storz Instruments Inc.

U.S. Court of Appeals Federal Circuit

No. 00-1482

Decided July 25, 2001

Headnotes

PATENTS

[1] Practice and procedure in Patent and Trademark Office — Reissue — Broader claims sought (§110.1313)

Patentability/Validity — Construction of claims (§115.03)

Patent construction — Prosecution history estoppel (§125.09)

Plaintiff's reissue claim for intraocular lens is invalid on ground of improper recapture of subject matter surrendered during prosecution to avoid prior art rejections, since reissue claim eliminated limitation on shape of "haptics" element of lens, and thus is broader than corresponding claim of original patent, since this broadened aspect of claim relates to surrendered subject matter, in that shape of haptics was same subject matter that was surrendered during prosecution of original application, and since recapture was not avoided by addition, on reissue, of limitations on haptics' dimensions and positioning, which do not narrow claim in manner directly pertinent to specific aspect that was narrowed during prosecution, namely, shape of haptics.

Particular Patents

Particular patents — General and mechanical — Intraocular lens

Re. 35,525 (of 4,435,855), Pannu, universal intraocular lens and a method of measuring an eye chamber size, summary judgment of invalidity affirmed.

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Case History and Disposition

Appeal from the U.S. District Court for the Southern District of Florida, Dimitrouleas, J.

Action by Jaswant S. Pannu and Jaswant S. Pannu M.D., P.A. against Storz Instruments Inc. for patent infringement, in which defendant counterclaimed seeking declaratory judgment of invalidity. District court granted defendant's motion for summary judgment of invalidity, and plaintiff appealed. Affirmed.

Related decision: 47 USPQ2d 1657.

Attorneys:

Michael C. Cesarano, of Senterfitt & Eidson, Miami, Fla., for plaintiffs-appellants.

Edward W. Remus and Jonathan R. Sick, of McAndrews, Held & Malloy, Chicago, Ill.; Craig E. Larson, of Bausch & Lomb Inc., Rochester, N.Y.; Rita D. Vacca, of Bausch & Lomb Surgical Inc., St. Louis, Mo., for defendant-appellee.

Judge:

Before Mayer, chief judge, Friedman, senior circuit judge, and Rader, circuit judge.

Opinion Text

Opinion By:

Mayer, C.J.

Jaswant S. Pannu and Jaswant S. Pannu, M.D., P.A. (collectively Pannu) appeal the judgment of the United States District Court for the Southern District of Florida, *Pannu v. Storz Instruments, Inc.*, 106 F. Supp. 2d 1304 (S.D. Fla. 2000), granting summary judgment for Storz Instruments, Inc. (Storz) that U.S. Patent No. Re 32,525 is invalid under 35 U.S.C. §251, the recapture rule. Because the reissued patent improperly broadened claims in a manner directly pertinent to subject matter surrendered during prosecution, we affirm.

Background

In 1980, Pannu filed a patent application for an artificial intraocular lens, S/N 136,243 ('243 application). An intraocular lens is an artificial plastic lens that may be implanted in an eye to replace a natural lens. The '243 application disclosed a round lens called an "optic" that focuses light on the retina, and two or more elements called "haptics" that are attached to the optic and contact internal tissue in the eye for the purpose of positioning and securing the optic. The haptics in Pannu's application included "snag resistant" discs at the end. In 1981, Pannu filed a continuation-in-part application, S/N 261,953 ('953 application), based on the original '243 application. The '953 application added new matter, claiming a lens in which the haptics are "integrally molded" to the lens body, and the lens could be placed in either the anterior or posterior chamber of the eye.¹

Independent claim 1 of the '953 application reads as follows:

A posterior chamber intraocular lens comprising:
 a lens having a width and a thickness;
 a retention loop including a flexible strand having a width and a thickness and such strand is joined at one end to the lens and has an opposite free end;
 and a snag resistant disc joined to the flexible strand's free end;
 said snag resistant disc having a width which is at least 3 times greater than the thickness of the disc, at least 3 times greater than the width of the flexible strand, and at least 1/5 as great as the width of the lens for smoothly guiding the free end of the flexible strand across an inner edge of an iris when moving said strand into and out of a posterior chamber of an eye;
 said snag resistant disc lying in a plane sufficiently close to a plane of the lens so that both the disc and lens can fit into a posterior chamber behind an eye's iris.

The examiner rejected claims 1-14 as obvious under 35 U.S.C. §103 in light of four prior art references: U.S. Patent No. 4,159,546 (Shearing patent), a publication showing the "Lindstrom Centrex" lens, U.S. Patent No. 4,249,271 (Poler patent), and U.S. Patent No. 4,092,743 (Kelman patent). In response, Pannu filed a supplemental amendment that cancelled claims 1-7 and 10-14, added new claims 16-22, and modified claims 8 and 9 to be dependent upon claim 16.

Independent claim 16 reads as follows:

An intraocular lens comprising:
 a lens body;

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at least two flexible positioning and supporting elements integrally formed with said lens body and extending from the periphery of said lens body;
 said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference; and
 snag resistant means integrally formed on the free end of said elements for smoothly guiding the lens across eye tissue when implanting the lens.

Pannu raised six arguments for the patentability of claim 16 over the four prior art references, including the distinction of "a continuous substantially circular arc having a diameter greater than the diameter of the lens body ...which significantly enhance the easy insertibility of applicant's lens and significantly reduce any possibility of snagging delicate eye tissue."The examiner accepted Pannu's arguments, and allowed claim 16 subject to minor amendments to set forth precisely the structural details of the haptics. Claim 16 issued as claim 1 of U.S. Patent No. 4,435,855 ('855 patent) and reads as follows:

An intraocular lens comprising:
 a lens body;
 at least two spaced flexible positioning and supporting elements integrally formed with said lens body as a one piece construction and extending radially outward from the periphery of said lens body;

said elements defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end spaced from said periphery; and

snag resistant means integrally formed on the free end of said elements for smoothly guiding and positioning the lens across contacted eye tissue when implanting the lens,

said snag resistant means having an uninterrupted continuously smoothly curved outer periphery which merges with said free end and is substantially greater in size than the width of said flexible elements.

In 1985, Pannu filed an application for reissue of the '855 patent. The supplemental reissue oath stated that Pannu "unduly and without deceptive intent narrowed the claims beyond what was necessitated by the applied prior art by describing the shape of the outwardly extending elements as defining 'a continuous, substantially circular arc having a diameter greater than the diameter of the lens body.'" The examiner allowed Pannu to delete "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference and terminating in a free end" from claim 1. However, the examiner required Pannu to insert additional limitations into the last section of the claim. The last section of claim 1 reads as follows with italics indicating additions and bracketing indicating deletions:

said snag resistant means having an uninterrupted, continuously smoothly curved outer periphery which merges with said free end and is [substantially] *at least three times* greater in [size] *width than the width of said flexible elements, said snag resistant elements and said positioning and supporting elements being substantially coplanar*. The '855 patent reissued as U.S. Patent No. Re 32,525 ('525 reissue).

Pannu filed suit against Storz, alleging that intraocular lenses sold by Storz infringed the '525 reissue. Storz filed a counterclaim seeking a declaratory judgment of patent invalidity, and moved for summary judgment that the '525 reissue improperly recaptures subject matter Pannu surrendered in obtaining allowance of claim 1 of the '855 patent. The court granted Storz's motion for summary judgment of invalidity and Pannu appeals.

Discussion

"We review a district court's grant of summary judgment de novo." *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1365, 53 USPQ2d 1377, 1378(Fed. Cir. 2000). Determining whether the claims of a reissued patent violate 35 U.S.C. §251 is a question of law, which we review *de novo*. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1163(Fed. Cir. 1997); *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993). This legal conclusion can involve underlying findings of fact, which are reviewed for substantial evidence. *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647(Fed. Cir. 1998); *Mentor*, 998 F.2d at 994, 27 USPQ2d at 1524 (citing *Ball Corp. v. United States*, 729 F.2d 1429, 1439, 221 USPQ 289, 297(Fed. Cir. 1984)). However, summary judgment is appropriate only when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. *Vanmoor*, 201 F.3d at 1365, 53 USPQ2d at 1378.

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The underlying facts in this case are taken directly from the prosecution file histories and the claims of the '855 patent and the '525 reissue, and are not disputed. *See Hester*, 142 F.3d at 1484, 46 USPQ2d at 1651. Claim construction is a purely legal question, *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456, 46 USPQ2d 1169, 1174(Fed. Cir. 1998) (en banc), and therefore, comparison of the claims of the '855 patent and the '525 reissue is a purely legal question appropriate for summary judgment, *Westvaco Corp. v. Int'l Paper Co.*, 991 F.2d 735, 741, 26 USPQ2d 1353, 1358 (Fed. Cir. 1993) ("A determination of whether the scope of a reissue claim is identical with the scope of the original claim is a question of law, which we review de novo.").

The recapture rule "prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims." *Clement*, 131 F.3d at 1468, 45 USPQ2d at 1164. (Reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible) *Id.* (quoting *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525). Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." *Id.* "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." *Id.* Finally, (the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.) *Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

[1] With respect to the shape of the haptics, claim 1 of the '525 reissue is broader than claim 1 of the original '855 patent. Claim 1 of the '855 patent limited the haptics to "a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Claim 1 of the '525 reissue eliminated this limitation on the shape of the haptics. "A reissue claim that does not include a limitation present in the original patent claims is broader in that respect." *Hester*, 142 F.3d at 1480, 46 USPQ2d at 1648. In addition, Pannu's reissue oath admitted that he unnecessarily narrowed the scope of the claim with respect to the shape of the haptics. He stated that "the [haptics] may actually be of any shape as long as the elements terminate in a free end having snag resistant means as now recited in claim 1." Correction of Pannu's unnecessary narrowing of claim 1 must involve a corresponding broadening of the reissued claim.

Pannu argues that even if the reissued claim is broader, it did not relate to subject matter surrendered during prosecution. This argument is without merit. As originally filed, none of the claims in the '953 application limited the shape of the haptics. The examiner rejected claims 1-14 as obvious. In response to the rejection, Pannu filed a supplemental amendment canceling claim 1 and adding new independent claim 16. Claim 16 described the haptics as "defining a continuous, substantially circular arc having a diameter greater than the diameter of said lens body, said arc curved toward said lens circumference." Pannu argued to the examiner, "no such particular shape is disclosed by the lenses of either Shearing or Lindstrom. In fact, Shearing teaches away from the concept of a continuous substantially circular arc supporting strand ... [and] the Lindstrom lens illustrates a supporting strand with a somewhat irregular, elliptical shape." The addition of the "continuous, substantially circular arc" limitation to claim 16 and the statements made by Pannu to the examiner during prosecution of the '855 patent limited the claim to exclude an interpretation that did not include a continuous, substantially circular arc. *See Southwall Techs., Inc. v. Cardinal AG Co.*, 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1676(1995). The shape of the haptics was broadened during reissue and was the same subject matter that was surrendered during prosecution.

Pannu argues, however, that because the reissued claims were materially narrowed in other respects, the '525 reissue avoids the recapture rule. *See Hester*, 142 F.3d at 1482-83, 46 USPQ2d at 1649-50; *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165; *Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525. Instead of being "substantially greater" than the width of the haptics, the snag resistant means must now be "at least three times greater" than the width of the haptics. In addition, the snag resistant means must now be "substantially coplanar" with the haptics. Pannu argues that both modifications relate to the configuration of the haptics, and therefore, what is gained by the elimination of one limitation is given up by the addition of the other limitations.

The "continuous, substantially circular arc" limitation related to the shape of the haptics. The narrowing aspect of the claim on

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reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening. Furthermore, "if the patentee is seeking to recover subject matter that had been surrendered during the initial prosecution this flexibility of analysis is eliminated, for the prosecution history establishes the substantiality of the change and estops its recapture." *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1349, 48 USPQ2d 1631, 1634(Fed. Cir. 1998); *see also Mentor*, 998 F.2d at 996, 27 USPQ2d at 1525 ("[I]n this case, the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution. Mentor thus attempted to reclaim what it earlier gave up."). In prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a "continuous, substantially circular arc." On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections.

Conclusion

Accordingly, we affirm the judgment of the United States District Court for the Southern District of Florida.

AFFIRMED

Footnotes

1 The eye is considered to have two chambers separated by the iris. The anterior chamber lies between the back surface of the cornea and front surface of the iris. Attorneys' Dictionary of Medicine and Word Finder A-280 (1995). The posterior chamber is the space between the back surface of the iris and the front surface of the crystalline lens. *Id.* at P-280.

- End of Case -

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(b) Reissue claims that are broader than the original patent claims with respect to the “surrender-generating limitation” will be barred by the recapture rule where there is narrowing of the claims not related to the “surrender-generating limitation.” As stated in the decision of *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim.

(c) Reissue claims that are both broader than the original patent claims with respect to the “surrender-generating limitation” and narrowed with respect to the “surrender-generating limitation” is a situation that requires some discussion.

In this situation, the claims are both broadened and narrowed in an aspect germane to the prior art rejection which caused applicant to insert the “surrender-generating limitation”

This can only happen where the limitation added to secure allowance of the original patent (the surrender-generating limitation) is deleted and a substitute limitation is added in its place. There are three possibilities as to the substitute limitation:

1. The substitute limitation is narrower than the “surrender-generating limitation” it replaces. The claim canceled in response to the rejection (in the application) was to Combination AB, and the replacement claim was to an ABC_{broad} combination. The reissue application recites the ABC_{specific} combination.

In this case, applicant has presented a narrowing as to the area of surrender and recapture does not apply. Even if the claims are broadened in some other respect not related to the surrender, recapture does not apply. See situation (a) above.

2. The substitute limitation is broader than the “surrender-generating limitation” it replaces. The claim canceled in response to the rejection (in the application) was to Combination AB, and the replacement claim was to an ABC_{specific}. The reissue application recites the ABC_{broad} combination. In this case, the substitute limitation is intermediate in scope between that of the patent claim containing the “surrender-generating limitation” and the application claim that was rejected over art (which claim did not have the “surrender-generating limitation.”)

In this situation, the record, including the specification and all argument/statements by the examiner, must be carefully reviewed to determine whether there is recapture. If the presentation of C_{specific} in response to the art rejection was accompanied by argument which would apply to C_{broad}, and the record (including the specification) supports this, there would not be recapture. If the argument would not apply to C_{broad}, or if there is no argument, then a recapture rejection should be applied.

3. The substitute limitation is “equal” in scope to the “surrender-generating limitation”